

REMARKS

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Claims 1-20 are now pending in this application. Each of claims 1,6, and 10 is in independent form.

I. “Adapted” Limitations Must Be Considered

The present Office Action asserts on page 4 that “claim scope is not limited by claim language such as ‘adapted to’ which suggests or makes optional but does not require steps to be performed” referring to MPEP Section 2111.4[R-3]. With all due respect, the MPEP is not the law. Instead, the MPEP sometimes accurately states the law, and other times merely presents preferences of the USPTO. Notably, “administrative regulations cannot trump judicial directives”, and neither can the wishes of the USPTO. *See, Agilent Tech., Inc. v. Affymetrix, Inc.,* __F.3d __, (Fed. Cir., 4 June 2009) (*citing Rowe v. Dror*, 112 F.3d 473, 479 (Fed. Cir. 1997) (note 2) (“Judicial precedent is as binding on administrative agencies as are statutes.”)).

The predecessor court to the Federal Circuit has interpreted the phrase “adapted” as preceding a “structural limitation”. *See, In re Venezia*, 530 F.2d 956 (CCPA 1976). Claim limitations preceded by “adapted” have been considered sufficiently definite. *See* MPEP 2173.05(g).

In addition, the Federal Circuit has interpreted the word “adapted” as preceding “functional language [that] limits the scope of these claims to devices that have the capability of” performing the stated function. *See, R.A.C.C. Indus., Inc. v. Stun-Tech, Inc.*, 178 F.3d 1309, 49 USPQ2d 1793 (Fed. Cir. 1998) (*cert. denied*, 526 U.S. 1098 (1999)) (cited with approval by MPEP 2106.IV.B). *See also K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1363 (Fed. Cir. 1999) (“[F]unctional language is, of course, an additional limitation in the claim”). Because such functional language serves as a claim limitation, a reference cited to support a rejection of a claim must describe a structure(s) capable of performing each claimed function preceded by the term “adapted.”

Further, in the case of *In re Land*, the CCPA ruled on a relevant claim that stated “said color-providing substances associated with at least the inner photosensitive emulsion layers are *adapted to be rendered diffusible* in said liquid composition *only after at least substantial development* of the next outermost photosensitive … layer has occurred.” *See, In re Land*, 368 F.2d 866, 151 USPQ 621, 635 (CCPA 1966). The CCPA noted that the italicized portions of the claim were functional and held the claim patentable in view of the **functional limitations**.

In yet another case, the Federal Circuit reversed an Examiner’s rejection of a patent claim due to the Examiner’s failure to provide patentable weight to **functional limitations**. *See, In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In still another case, *Central Admixture Pharmacy v. Advanced Cardiac*, 482 F.3d 1347 (Fed. Cir. 2007), the USPTO’s reviewing court found limitations preceded by the phrase “adapted to” to be definite:

[f]inally, ACS suggests that the patent’s Claim 13 and its dependent claims are invalid for indefiniteness, since they describe a solution that is “adapted to be diluted.” We do not read that phrase as possessing any significant ambiguity, much less intractable ambiguity making the claim “not amenable to construction,” which is the requirement to demonstrate indefiniteness.

Consequently, for at least the reasons listed above, Applicant respectfully requests full consideration of all the claimed subject matter per the applicable law.

II. The Obviousness Rejections

Each of claims 1-20 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable, over various combinations of U.S. Patent Application Publication 2001/0032271 (“Allen”), U.S. Patent 5,856,981 (“Voelker”), U.S. Patent 6,442,132 (“Burns”), U.S. Patent 6,741,572 (“Graves”), U.S. Patent 7,099,327 (“Nagarajan”), U.S. Patent 7,039,687 (“Jamieson”), U.S. Patent Application Publication 2001/0036153 (“Saski”), a paper “Generalized MPLS Signaling,” May 2001 (“Berger”), a paper “Constraint-based LSP Setup by Message Reversing of CR-LDP”, February 2001, (“Kim”), and/or a paper “ReSerVation Protocol with Traffic Engineering Extensions”, April 2001 (“Kini”).

Each of these rejections is respectfully traversed.

A. Legal Standards

1. Overview of *Prima Facie* Criteria for an Obviousness Rejection

The Patent Act, namely, 35 U.S.C. 103, forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.”

Relatively recently, in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), the Supreme Court interpreted this law while highlighting the typical invention process.

“Inventions usually rely upon building blocks long since uncovered, and claimed discoveries almost necessarily will be combinations of what, in some sense, is already known” (emphasis added). Yet, to properly apply §103, the Court recognized the need to filter, via obviousness analyses, true inventions from mere ordinary technological advances. “Granting patent protection to advances that *would occur in the ordinary course* without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility” (emphasis added).

Obviousness is a legal question based on underlying factual findings. *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000). In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), 148 USPQ 459, the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

Thus, factual determinations include, *inter alia*, the scope and content of the prior art, the level of skill in the art at the time of the invention, the objective evidence of nonobviousness, the presence or absence of a reason to combine, and whether a reference constitutes analogous prior art. See *In re Biggio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004); *Gartside*, 203 F.3d at 1316; *Paramount Ordinance Mfg. v. SGS Imps. Int'l.*, 73 F.3d 1085, 1088 (Fed. Cir. 1995); *In re GPAC, Inc.*, 57 F.3d 1573, 1577 (Fed. Cir. 1995). “What the prior art teaches and whether it teaches toward or

away from the claimed invention also is a determination of fact.” *Para Ordinance Mfg.*, 73 F.3d at 1088 (*citing In re Bell*, 991 F.2d 781, 784 (Fed. Cir. 1993)).

KSR warned that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”. Instead, “[i]n determining whether the invention as a whole would have been obvious under 35 U.S.C. 103, we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification. . . Just as we look to a chemical and its properties when we examine the obviousness of a composition of matter claim, it is this invention **as a whole**, and not some part of it, which must be obvious under 35 U.S.C. 103.” *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6,8 (CCPA 1977) (emphasis in original).

KSR further explained that any proposed combinations of prior art can only support a finding of obviousness if “there was an apparent reason to combine the known elements in the way” claimed. If that proposed combination involves multiple patents”, those patents must provide “interrelated teachings”. *KSR* further clarified that the “[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art”. Thus, in determining obviousness, both *KSR* and *Graham* warned against a “temptation to read into the prior art the teachings of the invention in issue” and instructed to ““guard against slipping into the use of hindsight””.

To effectively guard against hindsight, *KSR* emphasized the “import[ance]” of “identify[ing] a **reason** that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**” (emphasis added). That is, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning** with some rational underpinning to support the legal conclusion of obviousness” (*quoting In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006) (emphasis added)). Thus, “[t]o facilitate review, this analysis should be made explicit”.

Explaining the need for “**a reason that would have prompted** a person of ordinary skill”, *KSR* further taught that “if a **technique** has been used to **improve** one device, and a person of ordinary skill in the art **would recognize** that it would improve similar devices in the

same way, using the technique is obvious unless its actual application is beyond his or her skill” (emphasis added). Further exploring this mandate, the Federal Circuit has held that “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references”. *Innogenetics v. Abbott Laboratories*, 512 F.3d 1363, 1373 (Fed. Cir. 2008).

Thus, according to the Supreme Court, a proper obviousness rejection must “identify a reason that **would** have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” and must present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination. It follows that if the alleged reason for making the particular combination of features is not evidenced to be art-recognized, then that reason **must be** based on hindsight.

In addition to establishing a proper reason to combine, a proper obviousness rejection must clearly identify proposed reference(s) that:

1. are pertinent;
2. provide a reasonable expectation of success; and
3. teach... all the claim limitations

See MPEP 2143; MPEP 2143.03, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); and additional citations *infra*.

The Federal Circuit has further held that “[w]hen there is a design need or market pressure to solve a problem”, obviousness is not supported unless “a finite, and in the context of the art, small or easily traversed, number of options” “**would** convince an ordinarily skilled artisan of obviousness”. *Ortho-McNeil Pharmaceutical Inc. v. Mylan Laboratories Inc.*, 520 F.3d 1358, 1364 (Fed. Cir. 2008).

Consistent with other patentability rejections, to establish a *prima facie* case of obviousness, substantial evidence must be provided that fulfills the mandates of the applicable law. The “Patent Office has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). “It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis”. *Id.*

Moreover, it is legal error to “substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results.” *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

Only when “the examiner... carries the burden of making out a *prima facie* case of unpatentability, [does] ‘the burden of coming forward with evidence or argument shift[] to the applicant.’” *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. The Applied Reference(s) Must Present All Claim Limitations

“To establish a *prima facie* case of obviousness... the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP 2143.

The proposed modification or combination must provide the structure recited in the claims and produce the result attained by that structure. *See In re Schulpen*, 390 F.2d 1009 (C.C.P.A., 1968).

B. Analysis

1. All Claims

a. Characterizations of the Claimed Subject Matter

To the extent that any past Office Action, the present Office Action, or any future Office Action attempts to characterize the subject matter of any claim without quoting the actual language of that claim, Applicant respectfully traverses.

2. Claims 1-20

a. Missing Claim Limitations

Each of independent claims 1, 6, and 10, from one of which each of claims 2-5, 7-9, and 11-20 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, a “responsive to a determination that the label switched path has been switched to the service path, sending a **release request** to a plurality of nodes along the restoration path, the release request adapted to cause a release of a

restoration path resource allocation, the label switched path switched responsive to a repair of a failure of at least one component comprised by the service path, the release request an RSVP-TE protocol request comprising a shared reservation flag adapted to cause the **release of the restoration path resource allocation without causing a release of reserved resources associated with the restoration path and without causing a removal of the restoration path**".

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, expressly or inherently teach **every** limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

CONCLUSION

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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